

**Remarks**

Claims 1-31 and 33-45 are now pending in this application. Claims 1-28 are allowed. Claims 29-43 are rejected. Claim 32 has been canceled without prejudice, waiver, or disclaimer. Claims 44 and 45 are newly added. Claims 3, 29, 37-41, 42, and 43 have been amended. No new matter has been added.

In accordance with 37 C.F.R. 1.136(a), a one-month extension of time is submitted herewith to extend the due date of the response to the Office Action dated December 11, 2003 for the above-identified patent application from March 11, 2004 through and including April 12, 2004. April 11, 2004 is a Sunday. In accordance with 37 C.F.R. 1.17(a)(1), authorization to charge a deposit account in the amount of \$110.00 to cover this extension of time request also is submitted herewith. In addition, an authorization to charge the deposit account for the newly added claim has been submitted herewith.

The rejection of Claim 38 under 35 U.S.C. § 102(b) as being anticipated by MX 100 (Operation and Maintenance Manual Transfer Switch Control Panel MX 100 Microprocessor Controller, (1999)) is respectfully traversed.

MX 100 describe a built in 7 day exerciser timer that is incorporated into an MX100 (page 9). Pressing an initiate switch will start a timer that will continue for 167 hours and 40 minutes (page 9). Along with initiating the timer, an LED will illuminate to indicate that the timer has started (page 9). After 167 hours and 40 minutes, a load test (ATS transfers to emergency) or a no load test (ATS signals a genset to start but does not transfer) occurs (page 9). The exercise mode is determined by an MX100 PC jumper location (TSL = load, TSNL = no load) (page 9). The test lasts for 20 minutes. A CDT exerciser LED will flash when the exercising is in progress (page 9). This 20 minute exercise does not include the time delay to retransfer to normal (T timer) when the ATS is transferred (load test) or the time delay engine stop (U timer) for either load or no load tests (page 9). Each MX100 microprocessor based ATS controller requires a relay/transformer box to apply line voltage to an ATS operator via coil control relays (page 14). A standard transition R/T box schematic for the relay/transformer box shows single phase emergency sensing and 3-phase normal sensing (page 16). A delayed transition R/T box schematic for the relay/transformer box shows single phase emergency sensing and 3-phase normal sensing (page 16)

Claim 38 recites an automatic transfer switch controller comprising “at least one phase sense board configured to expand a capability of said controller from single phase voltage sensing to multiple phase voltage sensing of voltages generated from one of a utility and an alternate power source.”

MX 100 does not describe or suggest an automatic transfer switch controller as recited in Claim 38. Specifically, MX 100 does not describe or suggest at least one phase sense board configured to expand a capability of the controller from single phase voltage sensing to multiple phase voltage sensing of voltages generated from one of a utility and an alternate power source. Rather, MX 100 describe a standard transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing and a delayed transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing. Accordingly, MX 100 does not describe or suggest at least one phase sense board as recited in Claim 38. For the reasons set forth above, Claim 38 is submitted to be patentable over MX100.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102 rejection of Claim 38 be withdrawn.

The rejection of Claims 29-31, 33-37, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over MX100 in combination with Schweitzer, III et al. (U.S. Patent No. 5,680,324) is respectfully traversed. Applicant notes that official notice is taken in rejecting Claims 33-37 and 43 (Office Action, page 3). Accordingly, Applicant assumes that Claims 33-37 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MX100 in combination with Schweitzer, III et al. and further in view of the official notice.

The rejection of Claims 29-31 and 42 under 35 U.S.C. § 103(a) as being unpatentable over MX100 in combination with Schweitzer, III et al. (U.S. Patent No. 5,680,324) is respectfully traversed.

MX100 is described above. Schweitzer, III et al. describe a microprocessor that includes a number of configuration jumpers, which are responsible for establishing certain initialization conditions, such as front panel port communications parameters (column 4, lines 26-31). The microprocessor also has the capability of providing an independent alarm output upon recognition of an alarm condition, by means of an alarm unit (56) (column 4, lines 31-

33). The alarm includes a light-emitting diode (LED) visual indicator (column 4, lines 33-34).

Claim 29 recites an automatic transfer switch controller configured to control an automatic transfer switch that switches between providing power from a utility power source and from an alternate power source, the controller comprising “a configuration section including a jumper panel that is built within said controller and that is configured to select a cycle for a clock.”

Neither MX100 nor Schweitzer, III et al., considered alone or in combination, describe or suggest an automatic transfer switch controller recited in Claim 29. Specifically, neither MX100 nor Schweitzer, III et al., considered alone or in combination, describe or suggest a configuration section including a jumper panel that is built within the controller and that is configured to select a cycle for a clock. Rather, MX100 describes a built in 7 day exerciser timer that is incorporated into the MX100 and Schweitzer, III et al. describe a microprocessor that includes a number of configuration jumpers, which are responsible for establishing certain initialization conditions, such as front panel port communications parameters. Accordingly, neither MX100 nor Schweitzer, III et al., considered alone or in combination, describe or suggest a jumper panel that is built within the controller and that is configured to select a cycle for a clock. For the reasons set forth above, Claim 29 is submitted to be patentable over MX100 in view of Schweitzer, III et al.

Claims 30 and 31 depend from independent Claim 29. When the recitations of Claims 30 and 31 are considered in combination with the recitations of Claim 29, Applicant submits that dependent Claims 30 and 31 likewise are patentable over MX100 in view of Schweitzer, III et al.

Claim 42 recites an automatic transfer switch controller comprising “jumpers that are located on a main control board on which a microprocessor is located and that are configured to receive jumper selections of frequencies and voltage levels sensed by said controller.”

Neither MX100 nor Schweitzer, III et al., considered alone or in combination, describe or suggest an automatic transfer switch controller recited in Claim 42. Specifically, neither MX100 nor Schweitzer, III et al., considered alone or in combination, describe or suggest jumpers that are located on a main control board on which a microprocessor is

located and that are configured to receive jumper selections of frequencies and voltage levels sensed by the controller. Rather, MX100 describes a standard transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing and a delayed transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing. Schweitzer, III et al. describe a microprocessor that includes a number of configuration jumpers, which are responsible for establishing certain initialization conditions, such as front panel port communications parameters. Accordingly, neither MX100 nor Schweitzer, III et al., considered alone or in combination, describe or suggest jumpers as recited in Claim 42. For the reasons set forth above, Claim 42 is submitted to be patentable over MX100 in view of Schweitzer, III et al.

The rejection of Claims 33-37 and 43 under 35 U.S.C. § 103(a) as being unpatentable over MX100 in combination with Schweitzer, III et al. and further in view of the official notice is respectfully traversed.

MX100 and Schweitzer, III et al. are described above. The official notice describes conventional voltages/frequencies used in power art systems (Office Action, page 3).

Claims 33-37 depend, directly or indirectly, from independent Claim 29 which recites an automatic transfer switch controller configured to control an automatic transfer switch that switches between providing power from a utility power source and from an alternate power source, the controller comprising “a configuration section including a jumper panel that is built within said controller and that is configured to select a cycle for a clock.”

None of MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest an automatic transfer switch controller as recited in Claim 29. Specifically, none of MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest a configuration section including a jumper panel that is built within the controller and that is configured to select a cycle for a clock. Rather, MX100 describes a built in 7 day exerciser timer that is incorporated into the MX100, Schweitzer, III et al. describe a microprocessor that includes a number of configuration jumpers, which are responsible for establishing certain initialization conditions, such as front panel port communications parameters, and the official notice describes conventional voltages/frequencies used in power art systems. Accordingly, none of MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest a

jumper panel that is built within the controller and that is configured to select a cycle for a clock. For the reasons set forth above, Claim 29 is submitted to be patentable over MX100 in view of Schweitzer, III et al. and further in view of the official notice.

When the recitations of Claims 33-37 are considered in combination with the recitations of Claim 29, Applicant submits that dependent Claims 33-37 likewise are patentable over MX100 in view of Schweitzer, III et al. and further in view of the official notice.

Claim 43 depends from independent Claim 42 which recites an automatic transfer switch controller comprising “jumpers that are located on a main control board on which a microprocessor is located and that are configured to receive jumper selections of frequencies and voltage levels sensed by said controller.”

None of MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest an automatic transfer switch controller recited in Claim 42. Specifically, none of MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest jumpers that are located on a main control board on which a microprocessor is located and that are configured to receive jumper selections of frequencies and voltage levels sensed by the controller. Rather, MX100 describes a standard transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing and a delayed transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing. Schweitzer, III et al. describe a microprocessor that includes a number of configuration jumpers, which are responsible for establishing certain initialization conditions, such as front panel port communications parameters, and the official notice describes conventional voltages/frequencies used in power art systems. Accordingly, none of MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest jumpers as recited in Claim 42. For the reasons set forth above, Claim 42 is submitted to be patentable over MX100 in view of Schweitzer, III et al. and further in view of the official notice.

When the recitations of Claim 43 are considered in combination with the recitations of Claim 42, Applicant submits that dependent Claim 43 likewise are patentable over MX100 in view of Schweitzer, III et al. and further in view of the official notice.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 29-31, 33-37, 42, and 43 be withdrawn.

Moreover, Applicant respectfully submits that the Section 103 rejection of Claims 29-31, 33-37, 42, and 43 is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None MX100, Schweitzer, III et al., or the official notice, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicant respectfully submits that it would not be obvious to one skilled in the art to combine MX100 with Schweitzer, III et al., or the official notice because there is no motivation to combine the references suggested in the cited art itself.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, MX100 teaches a standard transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing and a delayed transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing. MX100 also teaches a built in 7 day exerciser timer that is incorporated into an MX100. Schweitzer, III et al. teach

a microprocessor that includes a number of configuration jumpers, which are responsible for establishing certain initialization conditions, such as front panel port communications parameters. The official notice teaches conventional voltages/frequencies used in power art systems. Since there is no teaching nor suggestion in the cited art for the combinations, the Section 103 rejections appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejections of Claims 29-31, 33-37, 42, and 43 be withdrawn.

For at least the reasons set forth above, Applicant respectfully requests that the rejections of Claims 29-31, 33-37, 42, and 43 under 35 U.S.C. 103(a) be withdrawn.

The rejection of Claim 32 under 35 U.S.C. § 103(a) as being unpatentable over MX100 in combination with Schweitzer, III et al. and ASCO (ASCO Series 165 Automatic Transfer Switches (1999)) is respectfully traversed.

Claim 32 has been canceled.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claim 32 be withdrawn.

The rejection of Claim 41 under 35 U.S.C. § 103(a) as being unpatentable over MX100 is respectfully traversed.

MX100 is described above.

Claim 41 depends indirectly from independent Claim 38 which recites an automatic transfer switch controller comprising “at least one phase sense board configured to expand a capability of said controller from single phase voltage sensing to multiple phase voltage sensing of voltages generated from one of a utility and an alternate power source.”

MX100 does not describe or suggest an automatic transfer switch controller recited in Claim 38. Specifically, MX100 does not describe or suggest at least one phase sense board configured to expand a capability of the controller from single phase voltage sensing to multiple phase voltage sensing of voltages generated from one of a utility and an alternate power source. Rather, MX100 describes a standard transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing

and a delayed transition R/T box schematic for the relay/transformer box showing single phase emergency sensing and 3-phase normal sensing. Accordingly, MX100 does not describe or suggest at least one phase sense board as recited in Claim 38. For the reasons set forth above, Claim 38 is submitted to be patentable over MX100.

When the recitations of Claim 41 are considered in combination with the recitations of Claim 38, Applicant submits that dependent Claim 41 likewise is patentable over MX100.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claim 41 be withdrawn.

Moreover, Applicant respectfully submits that the Section 103 rejection of Claim 41 is not a proper rejection. The Office action combines a single prior art reference with mere assertions that elements of the claimed invention that are missing from the prior art reference are obvious without a citation to some reference work recognized as standard in the pertinent art. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify ASCO. Rather, each allegation of what would have been an obvious matter of design choice must always be supported by citation to some reference work recognized as standard in the pertinent art, and the Applicant given an opportunity to challenge the correctness of the assertion or the repute of the cited reference. Applicant has not been provided with the citation to any reference supporting the mere assertions of obviousness made in the rejection. Accordingly, for this reason alone, Applicant request that the Section 103 rejection of Claim 41 be withdrawn.

For at least the reasons set forth above, Applicant respectfully requests that the rejection of Claim 41 under 35 U.S.C. 103(a) be withdrawn.

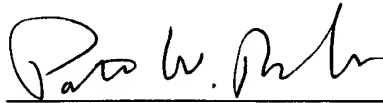
Newly added Claim 44 depends, directly or indirectly, from independent Claim 29, which is submitted to be in condition for allowance and patentable over the cited art. For at least the reasons set forth above, Applicant respectfully submits that Claim 44 is also patentable over the cited art.

Newly added Claim 45 depends, directly or indirectly, from independent Claim 42, which is submitted to be in condition for allowance and patentable over the cited art. For at least the reasons set forth above, Applicant respectfully submits that Claim 45 is also patentable over the cited art.



In view of the foregoing amendment and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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Patrick W. Rasche  
Registration No. 37,916  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070